

REMARKS

Claims 1-4, 6, 11, and 14-16 are now pending in this application. By this response to the Office Action dated September 4, 2008, claims 1, 2, 11, and 14 are amended, and claims 5 and 7 are canceled without prejudice. Applicants respectfully submit that an RCE is not required for the amendments to be entered and considered by Examiner, as the amendments are directed to canceling claims to expedite prosecution of this application, and addressing rejections made under 35 U.S.C. § 112. The amendments do not change the intended claim scope. Support for the amendments is found in the specification, including the claims, as originally filed. No new matter has been added. Favorable reconsideration of the application in light of the foregoing amendments and following comments is respectfully solicited.

Rejection Under 35 U.S.C. § 112, First Paragraph

In section 2 of the Office Action, claim 5 was rejected under 35 U.S.C. § 112, first paragraph. To expedite prosecution of this case, claim 5 is canceled without prejudice. Accordingly, Applicants respectfully request withdrawal of the rejection.

Rejection Under 35 U.S.C. § 112, Second Paragraph

In section 3 of the Office Action, claims 1, 7, and 11 were rejected under 35 U.S.C. § 112, second paragraph, as being indefinite. Applicants respectfully traverse.

Regarding claim 1, the phrase “encoded by the input code” is amended to “encoded in the input code,” to clarify the claimed subject matter.

Claim 7 is canceled without prejudice.

Regarding claim 11, the final paragraph is amended to eliminate use of the phrase “such that” to more clearly recite the claimed subject matter.

In view of the above amendments, Applicants respectfully submit that the pending claims comply with 35 U.S.C. § 112. Accordingly, Applicants respectfully request withdrawal of the rejection under 35 U.S.C. § 112, first paragraph.

Rejection Under 35 U.S.C. § 103(a)

In section 5 of the Office Action, claims 1-7 were rejected under 35 U.S.C. § 103(a) as being unpatentable over U.S. Patent No. 6,671,323 (Tahara) in view of U.S. Patent No. 6,075,900 (Sakazawa). On page 7 of the Office Action, claims 11 and 14-16 were rejected under 35 U.S.C. § 103(a) as being unpatentable over Tahara in view of Sakazawa. Applicants respectfully traverse.

Claim 1 recites, *inter alia*,

receiving an input code stored in a hierarchical data structure, the input code including
a parameter related to the amount of data encoded in the input code
...
generating an output code stored in the hierarchical data structure by modifying the input code, by
moving the user data to a third level of the hierarchical data structure, and
changing the parameter to reflect the change in code size effected by the moving.

Applicants recognized and have disclosed that where data is simply moved, the amount of data may exceed the limit of the parameter. Thus, embodiments of the claims change the parameter in advance before the user data is moved.

Page 5, lines 7-8 of the Office Action acknowledges that Tahara does not disclose the recited “changing the parameter.” Page 5, line 9 asserts that “Sakazawa discloses moving picture

data hierarchy information,” but does not assert or explain how Sakazawa cures the acknowledged shortcoming that Tahara does not disclose “changing the parameter” in accordance with the claims. Sakazawa fails to disclose a parameter relating to the size of the encoded data. Accordingly, it would not have been obvious, in view of a reference that fails to disclose the recited parameter, to change the parameter in accordance with claim 1.

Thus, claim 1 is not obvious in view of the cited art. Accordingly, Applicants respectfully request withdrawal of the rejection of independent claim 1, and dependent claims 2-4 and 6, as “dependent claims are nonobvious if the independent claims from which they depend are nonobvious.” *In re Fritch*, 972 F.2d 1260, 1266 (Fed. Cir. 1992); accord MPEP § 2143.03 (“If an independent claim is nonobvious under 35 U.S.C. 103, then any claim depending therefrom is nonobvious”).

Claim 11 recites, *inter alia*,

a multiplexing section which produces an output code in which the input code is modified by moving the user data to a third level of the hierarchical data structure, changing the parameter to reflect the change in code size effected by moving the user data, and including in the output code, the main data included in the input code.

For much the same reasons discussed above with respect to claim 1, the cited art fails to render obvious the recited “changing the parameter to reflect the change in code size effected by moving the user data.” Thus, claim 11 is not obvious in view of the cited art. Accordingly, Applicants respectfully request withdrawal of the rejection of independent claim 11 and dependent claims 14-16.

As noted previously, claims 5 and 7 are canceled without prejudice.


Conclusion

Accordingly, it is urged that the application, as now amended, is in condition for allowance, an indication of which is respectfully solicited. If there are any outstanding issues that might be resolved by an interview or an Examiner's amendment, Examiner is requested to call Applicants' attorney at the telephone number shown below.

To the extent necessary, a petition for an extension of time under 37 C.F.R. 1.136 is hereby made. Please charge any shortage in fees due in connection with the filing of this paper, including extension of time fees, to Deposit Account 500417 and please credit any excess fees to such deposit account.

Respectfully submitted,

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